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09/848,010	05/02/2001	Ioana M. Rizoia	B19485P	5692

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STOUT, UXA, BUYAN & MULLINS LLP  
4 VENTURE, SUITE 300  
IRVINE, CA 92618

EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/848,010

Applicant(s)

Reynolds et al

Examiner

d. shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on February 3, 2003.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-4, 7-15, 17-21, 23-35 and 37-120 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4, 7-15, 17-21, 23-35 and 37-120 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the ball roller; and the legs composed of a transparent material must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 39 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent lubricating a ball roller.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-15, 17-21, 23-35, and 37-120 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with indefiniteness. In all the claims the terms "moisture output" and "fluid output" are indefinite, as they appear to be used interchangeably to refer to both the mechanism for outputting moisture or fluid and the moisture or fluid which is output by such

Art Unit: 3739

mechanism see e.g. claim 94 “the fluid output comprises water and is constructed to simultaneously place water...”. Other claims dependent on method claims (e.g. claim 31) include preambles such as “The apparatus as set forth in claim 31...” (See e.g. claims 55-59). For examination purposes such claims will be treated as method claims. Further the focusing or directing steps do not manipulatively define over those of claim 31. Claim 54 purports to depend from claim 31a and is indefinite, as no such claim exists. Claim 54 will be treated as depending from claim 31. Claim 41 is indefinite because the term “the source of electromagnetic radiation” lacks positive antecedent basis. Claims 91, 100, and 112 all recite the surface contacted by the contacting leg, which is the skin as such these claims and their dependants are indefinite for claiming the body and further indefinite because it is unclear what further structure is recited thereby. Claim 101 is indefinite as it is unclear what further structure is to be claimed by reciting the intended use of the device. Claim 102 is indefinite because the exact meaning of the term “comprising s rounded foot” is unclear. For the purposes of examination “s” will be read as -- a --. Claims 110 and 111 are incomplete as they recite the fluid being output, but no fluid per se or reservoir therefor is recited in the independent claim. The indefiniteness involving the term “absorption” and the modifications thereof is again brought to applicant’s attention. While applicant’s comment that “any similarity in operating parameters ... may result from the fact that both applications are directed at least in part to dermatological treatment procedures” is noted, this does not alter the basic physical properties of water (e.g. the extent to which various wavelengths of light are absorbed thereby) and thus the fact that all the disclosed wavelengths are specifically discussed as highly absorbed in the parent, still renders the term indefinite, as it is unclear how they suddenly become “not highly absorbed” herein. The claims are replete with

Art Unit: 3739

indefiniteness and the forgoing is an exemplary list of the indefinitenesses. While, due to the bulk of the claims at bar, not each claim containing an indefiniteness has been specifically mentioned, an example of each type of indefiniteness has been given and applicant has been put on notice that these indefinitenesses exist in the claims. The failure of applicant to correct an indefiniteness in a claim which has not been specifically mentioned as containing that particular indefiniteness, but which particular indefiniteness has been pointed out as extant in the claims at large (e.g. preamble of claims dependant on method claims reciting the method claims as apparatus claims) and subsequent rejection of the uncorrected claims will not constitute a new grounds of rejection.

The indicated allowability of claim 5 is withdrawn in view of the newly discovered reference(s) to Fuller et al. Rejections based on the newly cited reference(s) follow.

The examiner apologizes for the erroneous indication of the allowability of claims 29, 30, and 37 and further apologizes for the erroneous application of Rizoiu et al (WO '928) under section, 102 (e) of 35 USC in the previous office action. After a more thorough review of this reference, the invention sought to be patented in claims 29, 30, and 37 is either anticipated, or made obvious thereby as more fully set forth below.

Claims 1, 32, 38, 53-59, and 82-88 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rizoiu et al (WO '928).

See for example claims 1-4; the paragraph bridging pages 52 and 53; the paragraph bridging pages 54 and 55; and the paragraph bridging pages 10 and 11.

Claims 33, 62, 99, 100, 108, 112, and 119 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Itzkan.

The liquid of Itzkan is not completely transparent to the radiation and thus at least a portion of the liquid will absorb at least a portion of the radiation. The liquid will be heated to some extent by such absorption, and will expand to the extent that it is heated, thereby exerting a "disruptive force" on the tissue which is beneath it. See figure 2 of Itzkan.

Claims 29-32, 37, 38, 48-59, and 77-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over RizoIU et al (WO '928) in combination with Vassiliadis et al. RizoIU et al (WO '928) provide the teachings set forth above and additionally teach the use of the electromagnetically induced mechanical cutter in conjunction with a variety of conventional tools including lasers (see page 47, line 22 through page 55, line 21). Vassiliadis et al teach that irradiating a tooth at low levels can desensitize the tooth and enable more rapid removal of dentin by conventional laser means (see column 5, line 7-30) and to employ the cutting laser when the water is not being sprayed (see column 6, lines 5-14) and that tissue can be removed bloodlessly. It would have been obvious to the artisan of ordinary skill to employ the laser steps of Vassiliadis wherein tissue is removed quickly by thermal cutting, in the method of RizoIU et al (WO '928), since this would provide rapid tissue removal for a large amount of tissues, while enabling the thermally damaged tissue remaining to be removed by the non-thermal cutting of RizoIU et al (WO '928), since this would save time and be less stressful on the patient, as taught by Vassiliadis et al or to employ the non thermal cutting steps of RizoIU et al (WO '928) in the method of Vassiliadis et al, since this would leave only healthy, viable tissue with a good bonding surface, as taught by RizoIU et al (WO '928) thus producing a method such as claimed.

Claims 33-35, 60-76, 99-109 and 111-120 are rejected under 35 U.S.C. 103(a) as being unpatentable over RizoIU et al (WO '928) in combination with RizoIU et al (1994 "The

Art Unit: 3739

Efficiency ...”) and Sharon et al. Rizoïu et al (WO ‘928) teach a device as claimed except for the leg (please note all structures predicated on the contacting leg e.g. the shape thereof) are also not taught. Rizoïu et al (1994 “The Efficiency ...”) teach that the effect described by Rizoïu et al (WO ‘928) requires that a certain distance be maintained between the fiber end and the tissue surface or no ablation will occur (see the paragraph bridging pages 110 and 111). Sharon et al teach the use of a variety of contacting devices to maintain an appropriate distance between the laser emission end of a applicator and the tissue surface (see figures 1-11) wherein the coupling is considered part of the housing. Thus it would have been obvious to the artisan of ordinary skill to employ the single legged, double legged, or transparent members of Sharon et al, since these are useful for maintaing the device an appropriate distance from the tissue, as taught by Sharon et al in the device of Rizoïu et al (WO ‘928), since maintaining the distance is important to produce ablation, as taught by Rizoïu et al (1994 “The Efficiency ..”); to employ a plurality of contact legs, since this is not critical, provides no unexpected result, and enables the excess water and removed tissue to be removed, which is desirable as taught by Rizoïu et al (WO ‘928) and to provide transparent legs, since the transparency of the legs does not in any way impede this function; to form the transparent portions from plastic, since this is not critical, provides no unexpected result, and plastics are notorious as transparent materials, officical notice which is hereby taken; and to employ soft water, since this has less contaminants than hard water, thus producing a device such as claimed.

Claims 1-4, 8, 10-15, 17-21, 23-28, 39-47, 90-98 and 110 are rejected under 35

U.S.C. 103(a) as being unpatentable over Rizoïu et al (WO ‘928) in combination with Rizoïu et al (1994 “The Effect...”) and Sharon et al as applied to claims 33-35, 60-76, 99-109, and 110-

Art Unit: 3739

120 are above, and further in view of Fuller et al. Fuller et al teach the use of a roller ball and the use of a lubricating solution (see Figures 2-7 and column 4, lines 30-65). It would have been obvious to the artisan of ordinary skill to employ a ball roller with a lubricant as the skin contacting portion, since sliding friction can be problematic; to use a 5 mm distance, since this is within the range taught by Rizoio et al (1994 "The Effect ...") as required for producing the effect of Rizoio et al (WO '928) and to provide a rectangular edge or cylindrical shape since this is not critical, provides no unexpected result and are equivalent to the configurations of Sharon et al as they function in substantially the same way, thus producing a device such as claimed.


Claims 6, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizoio et al (WO '298) in combination with Rizoio et al (1994 "The Effect..."), Sharon et al, and Fuller et al as applied to claims 1-4, 8, 10-15, 17-21, 23-28, 39-47, 90-98 and 110 above, and further in view of Itzkan. Itzkan teaches routing the fluid delivery and suction lines through the support leg of a distance member. It would have been obvious to the artisan of ordinary skill to route the fluid lines through the contact member, since this is adjacent the contact area which is where the moisture is desired to be situated to produce the effect described by Rizoio et al (WO '928), as taught by Rizoio et al (1994 "The Efficient ...") thus producing a device such as claimed.

Applicant's arguments with respect to claims 1-4, 6-15, 17-21, 23-35, and 36-120 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/DI

April 24, 2003



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330